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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/405,269	09/23/99	ALBERTE	01

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IM71/0314

EXAMINER
YAMNITZKY, M

ART UNIT 774

PAPER NUMBER

03/14/01

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/405,269

Applicant(s)
Randall S. ALBERTE et al.

Examiner
M. Yamnitzky

Group Art Unit
1774



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one (1) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-88 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-88 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The numbering of claims is not accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Page 57 of the application as originally filed contains two claims numbered 47 and two claims numbered 48. Misnumbered claims 47-86 (where misnumbered claims 47 and 48 are the second set of claims 47 and 48 in the originally filed application) have been renumbered as claims 49-88, respectively. In accordance with this renumbering of the claims, the dependency of claims 76-88 has been changed from "73" to --75--.

2. The disclosure is objected to because of the following informalities: Most of the specification pages and all claim pages except for the first page of claims do not have a top margin of at least 2.0 cm (3/4") as required by 37 CFR 1.52. Text from the first line of each page having an insufficient margin has been inadvertently deleted when holes were punched in the pages for placement in the application file.

Appropriate correction is required. A substitute specification including claims is required pursuant to 37 CFR 1.125(a) because of the improper page margins.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification, any previously entered amendment under 37 CFR 1.121, and the

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corrected (renumbered) claim numbering noted above. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

The substitute specification need not be submitted in order for a response to the requirements for restriction and election of species set forth below to be deemed to be complete. If a substitute specification is not provided in response to this communication, applicant will be reminded of the requirement in the first Office action on the merits. However, it would be helpful if at least a substitute copy of claim pages 54-60, with correctly numbered claims, would be submitted in response to this communication so that the examiner does not have to guess the missing text for the first line on each of these pages.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-74, drawn to a system (claims 1-38) or a coating (claims 39-74) comprising an anti-fouling compound represented by general structure 1, classification dependent upon the identity of X, Y and Z in general structure 1.
 - II. Claims 75-88, drawn to an article of manufacture for use in a health-related environment, classification dependent upon what the article of manufacture actually is.

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4. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group II and Group I are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination, while requiring an antifouling compound, does not require an antifouling compound of general structure 1. The subcombination has separate utility by itself.

5. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, and vice versa, restriction for examination purposes as indicated is proper.

6. In addition to the preceding restriction requirement, an election of species is also required.

This application contains claims directed to the following patentably distinct species of the claimed invention of Group I: the numerous compounds of general structure 1 as shown in claims 1 and 39 wherein

X represents (i) -OH, (ii) -O(aryl), (iii) -O(acyl), (iv) -O(sulfonyl), (v) -CN or (vi) F, Cl or Br;

Y represents (i) O, (ii) S, (iii) Se or (iv) NR;

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Z represents optionally substituted (i) alkyl, (ii) heteroalkyl, (iii) cycloalkyl, (iv) heterocycloalkyl, (v) aryl, (vi) heteroaryl, (vii) aralkyl, (viii) heteroaralkyl, or (ix) $-(CH_2)_m-R_{80}$;

R represents (i) hydrogen, (ii) alkyl, (iii) heteroalkyl, (iv) aryl, (v) heteroaryl, (vi) aralkyl, (vii) heteroaralkyl, or (viii) $-(CH_2)_m-R_{80}$; and

R_{80} represents (i) aryl, (ii) cycloalkyl, (iii) cycloalkenyl, (iv) heterocyclyl, or (v) polycyclyl; and wherein the compound of general structure 1 is (a) applied to the exterior surface of a living organism, (b) on the surface of a medical device, (c) on the surface of an implant or (d) on the surface of a graft.

This application contains claims directed to the following patentably distinct species of the claimed invention of Group II: the individual articles of manufacture recited in the groups set forth in claims 79 and 80.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 25, 30-33, 39, 63, 64, 66-70 and 74 are generic with respect to the election of species requirement for Group I. Currently, claim 75 is generic with respect to the election of species requirement for Group ~~I~~^{II}.

If applicant elects Group I in response to the restriction requirement, applicant is required to elect one of (i)-(vi) for X, one of (i)-(iv) for Y, one of (i)-(ix) for Z, and one of (a)-(c) in response to the election of species requirement. In addition, if (iv) is elected for Y, applicant is also required to elect one of (i)-(viii) for R. If (viii) is elected for R and/or (ix) is elected for Z,

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applicant is also required to elect one or two of (i)-(v) for R_{80} (two may be elected if the elected species contains more than one $-(CH_2)_m-R_{80}$). Applicant is further required to identify an ultimate species of the compound of general structure 1, consonant with the elected species, that can be used as the starting point for search and examination purposes. An ultimate species is a specific (single) compound.

If applicant elects Group II in response to the restriction requirement, applicant is required to elect one of the articles of manufacture recited in the group set forth in claim 79 or one of the articles of manufacture recited in the group set forth in claim 80.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. No telephone call was made to request an oral election to the above restriction and election of species requirement due to the complexity of the election of species requirement.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner can generally be reached at this number from 6:45 a.m. to 3:15 p.m. Monday-Friday.

The current fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes and (703) 305-5408 for all other official faxes. (Unofficial faxes for Art Unit 1774 can be sent to (703) 305-5436.)

MRY
03/13/00

Marie R. Yamnitzky

MARIE YAMNITZKY
PRIMARY EXAMINER

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